

Filed on behalf of: Cellco Partnership d/b/a Verizon Wireless

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS
Petitioner

v.

GENERAL ACCESS SOLUTIONS, LTD.
Patent Owner

IPR2023-00978
U.S. Patent No. 7,230,931

**PETITIONER'S REPLY TO PATENT
OWNER PRELIMINARY RESPONSE¹**

¹ Authorized by the Board's email dated October 23, 2023.

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I. GAS’S FINITIV ARGUMENT IS MOOT

Verizon submits, as Ex. 1020, a stipulation under *Sotera Wireless, Inc., v. Masimo Corp.*, No. IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential).

According to the Director, “the PTAB will not discretionarily deny institution ... where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” *Memorandum for the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*, at 3 (Jun. 21, 2022); *see also id.* at 7. Accordingly, the accompanying *Sotera* stipulation renders moot the *Finitiv* argument by Patent Owner GAS. *See* POPR, 57-60.

II. GAS’S 35 U.S.C. § 325(D) ARGUMENT FAILS

GAS seeks denial of institution under § 325(d) based on the Board’s prior consideration of Vornefeld in the Sprint IPR. POPR, 46-53. GAS’s argument is misguided. As the Petition explains, in the Sprint IPR, GAS *conceded* that Vornefeld taught the features of the independent claims and the Board ruled those claims *unpatentable*. Pet., 10-12. The Petition accepts that finding by citing Vornefeld against the cancelled independent claims. Pet., 1-3, 15-29. The challenged claims depend from those independent claims. The Petition relies upon previously unapplied references (in combination with Vornefeld) to address the features of the challenged claims. *See, e.g.*, Pet., 29-38.

GAS cites *Becton* and *Advanced Bionics* for the proposition that the Board’s prior consideration of Vornefeld supports discretionary denial. However, *Becton*, *Advanced Bionics*, and § 325(d) seek to avoid relitigating arguments that the Office already rejected, which is why a petitioner should address the error made by the Office in such cases. *See Advanced Bionics LLC v. Med-EL Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) (precedential) (“[i]f the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute”; “whether ... the Office erred”); *see id.* at 10 (“material error by the Office”), 11 (“whether the Office erred”). Verizon does not allege an error under *Becton* because the Board did not err—it found claims 1 and 19 unpatentable over Vornefeld, as GAS conceded. Ex. 1009, 7.

Verizon simply accepts the undisputed findings concerning Vornefeld’s application to the cancelled independent claims in the adverse judgement against GAS. GAS’s request for discretionary denial seeks to void the prior Board ruling (and GAS’s own admission in the prosecution history). Thus, GAS’s argument is antithetical to the principle embodied in § 325(d)—accepting prior findings by the Office. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 8-11.

Also, under *Becton*, the Board may consider other relevant factors. *See Consolidated Trial Practice Guide* (Nov. 2019) at 63. Here, the most relevant factors are that (i) the prior application of Vornefeld against the independent

claims was *successful* and, (ii) under 37 C.F.R. § 42.73(d)(3), GAS is “precluded from taking action inconsistent with the adverse judgment” in the Sprint IPR.

Regarding the new Atsuta and Goldberg references applied against the challenged dependent claims, GAS offers conclusory statements (*see* POPR, 50) and fails to address that the Petition clearly articulates how those previously unapplied references render claims 28 and 29 unpatentable (*see* Pet., 23-47). Glaringly, GAS fails to address the Tangeman reference at all in its § 325(d) argument, which renders its argument incomplete, at best. POPR, 46-53.

While GAS offers that Goldberg was cited (for background) in a declaration in the Sprint IPR (POPR, 50), GAS fails to acknowledge that Goldberg was *not* (i) an exhibit in the Sprint IPR, (ii) mentioned or applied in the Sprint Petition, or (iii) addressed in the final written decision. *See* Exs. 1009, 1014. Thus, Goldberg was not previously considered by the Office. *See 3M Co. v. Westech Aerosol Corp.*, IPR2018-00576, Paper 49 at 7-8 (Feb. 4, 2020) (explaining that issues not briefed do not form part of the case); *see* 37 C.F.R. § 42.6(3).

III. GAS’S *GENERAL PLASTIC* ARGUMENTS FAILS

Concerning the first factor of *General Plastic* (the identity of the later petitioner), GAS repeats arguments rejected by the Board in the Order denying GAS’s discovery motion (Paper 14). Like the POPR, GAS’s Motion argued that Ericsson and Samsung should be considered undisclosed RPIs in both this IPR and

the Sprint IPR, and predicated its *General Plastic* theory on that unsupported assumption. See POPR, 53; Motion (Paper 11), 3-7. The Board explained that GAS's theory does not establish a relationship between the *petitioners* (Verizon here and Sprint previously) and instead presents allegations concerning Ericsson and Samsung, which are not petitioners in either IPR. Order (Paper 14), 9-10 ("Patent Owner has not demonstrated that there is more than speculation that there is a legally significant tie between the two petitioners."). In doing so, the Board rejected that the distinct petitioners' use of common suppliers suggested a "legally sufficient tie." *Id.* Yet, GAS repeats the argument here. POPR, 54 ("common suppliers"). And GAS again focuses on the wrong issue by alleging that Ericsson and Samsung should be deemed to "have a 'substantial relationship' with Sprint and Verizon," rather than establishing a substantial relationship between Verizon and Sprint. POPR, 55. Nor could it establish such a relationship where Verizon is a competitor of Sprint that was sued well after the Sprint IPR concluded.

Concerning factor 2 (whether the petitioner knew of the prior art at the time of the first petition), GAS points to Vornefeld as having been relied upon in the Sprint IPR. POPR, 56. GAS again ignores that Vornefeld is relied upon for features GAS has conceded Vornefeld teaches. GAS also ignores that factor 2 concerns the application of "new prior art." *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 10 (Sept. 16, 2017)

(precedential). GAS makes no allegation concerning the new prior and, thus, misses the mark. Further, Verizon was not sued until long after the filing of the Sprint IPR. *See* Pet., 4; Exs. 1009, 1016. Where the purpose of *General Plastic* is to provide “fundamental fairness of the process for *all parties*,” it would be illogical to assert that Verizon should have known of the new references at the time of the Sprint IPR, well before GAS even sued Verizon for infringement. *General Plastic*, IPR2016-01357, Paper 19 at 18 (emphasis added).

Similarly, for factors 3-5, GAS implies that Verizon should have pursued its IPR before the preliminary response in the Sprint IPR, despite GAS having not filed a complaint against Verizon until well after that time. POPR, 56-57. The timing of Verizon’s IPR stems from GAS’s litigation tactics, not any delay or gamesmanship by Verizon. *General Plastic*, IPR2016-01357, Paper 19 at 20; *see W. Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00084, Paper 14 at 18 (Apr. 25, 2018) (discounting factors that are a “result of [PO’s] own litigation activity”).

Regarding factors 6-7, GAS relies upon “the Board’s finite resources.” POPR, 57. However, per the Director, the more important consideration is patent quality, which would suffer here absent substantive review. *Code200, et al. v. Bright Data Ltd.*, IPR2022-0086, Paper 18 at 6 (Aug. 23, 2022) (precedential).

IV. CONCLUSION

GAS’s discretionary denial arguments fail and review should be instituted.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petitioner's Reply to Patent Owner Preliminary Response was served on this date via email to the following addresses:

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